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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971,960 11/17/97 STILZ H 026083/0138

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HM22/1222

EXAMINER

GAZI, S

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

12/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/971,960

Applicant(s)

Stilz et al.

Examiner

Sabiha Qazi

Group Art Unit

1616



☒ Responsive to communication(s) filed on Nov 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-24 and 39-103 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-24 and 39-103 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound (example 58, page 77), when benzodioxarane (six membered) is the only hetero group other than imidazole, classified in class 514, subclass 451+.

II. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound (example 54, page 76), when benzodioxarane (five membered) is the only hetero group other than imidazole, classified in class 514, subclass 461+.

III. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound when pyridyl is the only hetero group other than imidazole, classified in class 514, subclass 188+.

IV. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound when morpholin is the only hetero group other than imidazole, classified in class 514, subclass 231.2+.

V. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound when pyrimidine is the only hetero group other than imidazole, classified in class 514, subclass 256+.

VII. Claims 21-24 and 39-103 are drawn to the composition and method of use of the compound when quinolyl is the only hetero group other than imidazole, classified in class 514, subclass 311+.

If applicants want to elect any other invention than those cited above, they may elect a species and Examiner will build a group of subgenus falling in the species for examination.

The inventions are distinct each from the other because of the following reasons:

1. Inventions in Group I and Group II-VII are not related to each other, they are structurally dissimilar, as can be seen that group I is drawn to the methods of compounds when hetero group in

is dioxane which is classified in class 514/451+ whereas group III is drawn to methods of compounds when hetero group represents pyridinyl, classified in class 514/188+. These compounds have different cores and the search for one group will not be the same as required for the other group.

The groups I-VII as outlined above are drawn to structurally dissimilar compounds of varying cores and functional moieties which are separately classified, require separate searches, and are not art recognized equivalents. For example the search for the methods of compounds when it contains pyrimidine would be different from the search of the method of compounds when hetero group is pyridine. They are patentably distinct.

Burden is likewise demonstrated by divergent classification as well separate database search for the entire genus would represent excessive burden on the examiner.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is requested to elect a single species from the elected group for the search purposes.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. A telephone call was made to Attorney on 12/1/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action.

Telephonic inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Sabiha N. Qazi Ph.D.

12/19/99

Examiner, Art Unit 1616